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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,949	01/22/2001	Daniel B. Workman	OID06-36(07601)	3380
58403 7590 08/20/2008 BARRY W. CHAPIN, ESQ. CHAPIN INTELLECTUAL PROPERTY LAW, LLC WESTBOROUGH OFFICE PARK 1700 WEST PARK DRIVE, SUITE 280 WESTBOROUGH, MA 01581				
EXAMINER BASEHOAR, ADAM L				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

09/766,949

**Applicant(s)**

WORKMAN ET AL.

**Examiner**

ADAM L. BASEHOAR

**Art Unit**

2178

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 4-13, 17-22, 25-31, 41 and 44-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4-13, 17-22, 25-31, 41 and 44-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This action is responsive to communications: The Amendment filed 05/09/08.
2. Claims 2, 3, 15, 16, 23, 24, 42, and 43 have been cancelled as necessitated by Amendment.
3. Claims 13, 25-31, 41, and 44-50 remain rejected under 35 U.S.C. 101.
4. Claims 1, 4-13, 17-22, 25-31, 41, and 44-50 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Bergman et al (5,909,678 06/01/99) in view of Kurowski et al (US-2002/0019844 02/14/02) in further view Nunez (US-6,654,737 11/25/03) in further view of the W3C, HTML 4.01 Specification, Chapter 12, "Links", pp. 1-15, 12/24/99 (Hereafter: W3C).
5. Claims 1, 4-13, 17-22, 25-31, 41, and 44-50 are pending in the case. Claims 1, 11, 13, and 41 are independent claims.

***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 13, 25-31, 41, and 44-50 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In regard to claims 13 and 25-31 the computer usable medium could be communication/transmission medium for carrying data signals (Specification: Paragraph 32). Thus claims 13 and 25-31 are rejected under 101 for failing to fall within a statutory category of invention and for failing to be structurally and functionally interconnected with the software in such a manner to, in and of itself, enable usefulness to be realized. The Examiner suggests the claims be amended, "comprising a

computer readable memory device,” instead of “computer usable medium.” In regard to claims 41 and 44-50, the system means could be merely software (Note: Entire Specification). The computer system must be claimed in combination with an appropriate hardware element in order for functionality to be realized. Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1, 4-13, 17-22, 25-31, 41, and 44-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bergman et al (5,909,678 06/01/99) in view of Kurowski et al (US-2002/0019844 02/14/02) in further view Nunez (US-6,654,737 11/25/03) in further view of the W3C, HTML 4.01 Specification, Chapter 12, “Links”, pp. 1-15, 12/24/99 (Hereafter: W3C).

-In regard to independent claims 1, 11, 13, and 41 Bergman et al teach a method, system, and product for editing a form, wherein;

a user was displayed an interface (Fig. 9: 911) displaying a phrase receptacle (Fig. 2: 210), for an element in the form (column 3, lines 6-18)(Fig. 4: 201), the form being a database query (column 5, lines 27-36; column 7, lines 22-30: “user queries...by a specific database”), indicating to a user that a control is available for the element (column 3, lines 6-28, 46-49, 57-67; column 4, lines 1-9), said phrase receptacle including a at least one target (column 7, lines 31-

44), the target identified by a link to a choice satisfying the element on the form (column 4, lines 15-20: "has a choice of objects and a choice of phrases"; column 7, lines 30-49: "enforce semantic constraints...see the phrase and objects that the palette will accept highlighted in the menu boxes")(Fig. 2: 11, 12), said phase receptacle providing one of a group consisting of a link from the form to another location and a link from the form to another file (column 7, lines 31-44: i.e. selecting a given phrase receptacle enforces semantic constraints that link to the appropriate phrase and objects in the different menu boxes), wherein the another location and another file was identified by a reference to valid variables/a selection of choices (column 3, lines 5-22: "query options, query variables, query choices...specified or selected by a user"; column 4, lines 15-20: "has a choice of objects and a choice of phrases"; column 7, lines 30-49: "enforce semantic constraints...see the phrase and objects that the palette will accept highlighted in the menu boxes")(Fig. 2: 11, 12); wherein

upon selection of the phrase receptacle of the element, presenting the control displayed on the user interface for user interaction (column 7, lines 31-44)(Fig. 3: Selection of element 200 displays highlighted menu control 11 for user interaction); and wherein

upon completion of user interaction with the control, replacing the element with a new element responsive to user (column 7, lines 50-56: "user has dragged and dropped the object...from the object menu 11 into box 210")(Fig. 2: Select element 210 and Fig 3: Replace element with new element 210 selected from control 11).

Bergman et al do not teach wherein the phrase receptacle (Fig. 2: 210) was a hyperlink to the object menu (Fig. 2: 11). Kurowski et al teach wherein activating hyperlinks generates menu views, wherein a user could then make a plurality of selections from the generated menu based

on which hyperlink the user selected (Paragraph 184: "page may include hyperlinks that activate things....activate...menu...include...options"). It would have been obvious to one of ordinary skill in the art at the time of the invention for the clickable/selectable phrase receptacles of Bergman which associated with a plurality of menus to have activated those menus via a hyperlink in the phrase receptacle as taught in Kurowski et al, because Nunez taught that hyperlinks supplied the notoriously well known benefits of providing a computer assisted way for a human user to efficiently jump between various locations containing information which is somehow related (column 2, lines 10-17: "efficiently jump"). This hyperlink efficiency would have enhanced the query interface of Bergman et al which was concerned with making the interface as easy to use and flexible as possible (column 2, lines 43-50).

Neither Bergman et al, Kurowski et al, nor Nunez specifically teach wherein the hyperlink included a hyperlink target in the form of URL and wherein the another location or file was identified by the URL in the hyperlink target. W3C teaches wherein the basic hyperlink construct connects from one resource to another, wherein the hyperlink has two ends (Page 1: Section 12.1: "Introduction to links and anchors"). W3C further teaches wherein the hyperlink starts at a source and points to a destination which may be any resource (image, program, video, document, an element within a document, etc), wherein the hyperlink target includes a URL that specifies the address of the destination anchor (Page 2: Section 12.1.1: "Visiting a linked resource"). It would have been obvious to one of ordinary skill in the art at the time of the invention for the hyperlink targeting the generated menu resource to have included a URL of said destination target (i.e. the menu) as shown in W3C, because W3C taught that it was notoriously well known in the art at the time of the invention for hyperlinks to contain URLs

identifying the address of target resources so that a user selecting said hyperlink could easily jump to or activate said resource (Pages 1 & 2: "basic hypertext construct").

-In regard to dependent claims 4-5, 17-18, 25-26, and 44-45, Bergman et al teach wherein the element was part of a formula or calculation (column 3, lines 9-10)(column 14, lines 25-30).

-In regard to dependent claims 6-7, 19-20, 27-28, and 46-47, Bergman et al teach wherein the control was a list of choices or a pull-down menu (column 8, lines 5-8)(Fig. 3&4).

-In regard to dependent claims 8-9, 21-22, 29-30, and 48-49, Bergman et al wherein the control was a dialog box or text entry field (column 8, lines 6-8).

-In regard to dependent claims 10, 12, 31, and 50, Bergman et al further teach wherein the control was selected from a group of controls consisting of a list (Fig. 3), a dialog box, and a text entry field (column 8, lines 5-8).

### ***Response to Arguments***

10. Applicant's arguments filed 05/09/08 have been fully considered but they are not persuasive.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on

combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In general Applicant argues that the cited combination of references fails to teach or suggest the newly amended limitations of the independent claims. The Examiner respectfully disagrees with the Applicant. The Bergman et al reference clearly teaches wherein the form (Fig. 2: 201) was a database query (column 5, lines 27-36; column 7, lines 22-30: "user queries...by a specific database"). Bergman et al further taught wherein one or more phrase receptacles included one or more targets identified by a link to a choice satisfying the phrase receptacle on the form (column 4, lines 15-20: "has a choice of objects and a choice of phrases"; column 7, lines 30-49: "enforce semantic constraints...see the phrase and objects that the palette will accept highlighted in the menu boxes")(Fig. 2: 11, 12). Bergman et al finally taught wherein another location and/or another file were identified by a reference to valid variables or a selection of choices (column 3, lines 5-22: "query options, query variables, query choices...specified or selected by a user"; column 4, lines 15-20: "has a choice of objects and a choice of phrases"; column 7, lines 30-49: "enforce semantic constraints...see the phrase and objects that the palette will accept highlighted in the menu boxes")(Fig. 2: 11, 12). In general the Examiner notes that the Kurowski, Nunez, and WC3 references have been relied upon to teach the well known and advantageous benefits of menu driven hyperlinking between source and destination resources for the purpose of content selection. The Bergman et al reference in view of said other references is believed to teach each and every limitation of Applicant's claimed invention. Please note the rejection as detailed above.



***Conclusion***

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam L. Basehoar whose telephone number is (571)-272-4121. The examiner can normally be reached on M-F: 7:00am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2178

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Adam L Basehoar/

Primary Examiner, Art Unit 2178